THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte KAREN I. TROVATO

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Appeal No. 1998-2892
Application No. 08/576,621[1]

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ON BRIEF

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Before ABRAMS, McQUADE, and GONZALES, ***Administrative Patent Judges***.

ABRAMS, ***Administrative Patent Judge***.

DECISION ON APPEAL

This is an appeal from the decision of the examiner finally rejecting claims 1-21, which constitute all of the claims of record in the application.

[1] Application for patent filed December 21, 1995.

The appellant's invention is directed to computer software (claims 1 and 2), a computer method (claims 3, 4, 14 and 15), and a computer system (claims 5-13 and 16-21) for providing a game. The claims on appeal have been reproduced in an appendix to the Brief.

THE REFERENCES

The references relied upon by the examiner to support the final rejection are:

Lipscomb *et al*. (Lipscomb) 5,473,687 Dec. 5, 1995

Ken Perlin, (Perlin), "Real Time Responsive Animation with Personality," IEEE TRANSACTIONS ON VISUALIZATION AND COMPUTER GRAPHICS, Vol. 1, No. 1, March 1995, pp. 5-15.

THE REJECTIONS

Claims 1, 3-7, 9 and 10-12[2] stand rejected under 35 U.S.C. § 102(e) as being anticipated by Lipscomb.

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[2] Claim 11 was not listed in either of the rejections in any of the examiner's papers. However, it would appear that it should have been placed under the Section 102 rejection, in that it depends from claim 10, and we have so considered it.

Claims 2, 8 and 13-21 stand rejected under 35 U.S.C. § 103 as being unpatentable over Lipscomb in view of Perlin.

Rather than attempt to reiterate the examiner's full commentary with regard to the above-noted rejections and the conflicting viewpoints advanced by the examiner and the appellant regarding the rejections, we make reference to the final rejection (Paper No. 8) and the Appellant's Briefs (Papers Nos. 14 and 16).

OPINION

The Rejection Under 35 U.S.C. § 102(e)

The appellant's invention relates to a computer game that can be played simultaneously by a large number of users. Independent claim 1 is directed to computer software stored in a computer memory, which comprises means for receiving electronic map data and an environment growing code for growing an environment from the map data. Independent claim 3 is directed to a computer method comprising steps that include these two features. As explained by the appellant, "growing an environment" is intended to mean enhancing the two dimensional presentation provided by the map with additional information to

construct a simulated city or the like so that the game becomes more complex and interesting and can support more players.

These independent claims stand rejected as being anticipated[3] by Lipscomb, which is directed to a method for retrieving secure information from a database. One of the objectives of the Lipscomb invention is to discourage users who receive information from the database from improperly using it without providing suitable compensation to the owner. To this end, Lipscomb "explodes" the data items to an inconveniently large size by adding a mass of meaningless data so that the user will be discouraged from maintaining it in a permanent database or passing it to others. There is no mention in Lipscomb of using the system in the context of a game, nor of electronic map data or an environment growing code. Nevertheless, the examiner has taken the position that the subject matter of claims 1 and 3 is anticipated by Lipscomb. While the examiner has not explained his rationale in detail,

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[3] Anticipation is established only when a single prior art reference discloses, either expressly or under the principles of inherency, each and every element of the claimed invention. See, for example, ***In re Paulsen***, 30 F.3d 1475, 1480-1481, 31 USPQ2d 1671, 1675 (Fed. Cir. 1994).

apparently it is his theory that the Lipscomb system can be considered to be a “game” and the information processed by the system to constitute an “environment,” and that Lipscomb “grows” this environment from a small to a large one (see Answer, page 3). We do not agree. There is no support in Lipscomb for the examiner’s position; from our perspective, Lipscomb does not disclose either of the two elements required by claims 1 and 3, and therefore clearly does not anticipate the subject matter recited therein.

We therefore will not sustain the rejection of independent claims 1 and 3 or, it follows, of claims 4-7, 9 and 10-12, which are dependent from claims 1 and 3 and have been rejected on the same basis.

The remaining claims stand rejected as being unpatentable over Lipscomb in view of Perlin. The examiner’s position with regard to this rejection is that Lipscomb teaches all of the subject matter recited except for presenting avatar[4] data, which is taught by Perlin, and that one of ordinary skill in the art would have found it obvious to combine the teachings of

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[4] "The PC user’s persona in the virtual world” (appellant’s specification, page 6).

these two references in such a manner as to meet the terms of the claims because "the teaching of Perlin is compatible with the architecture of Lipscomb" (Paper No. 8, page 3). Claim 2 depends from claim 1, and claims 8 and 13-15 depend from claim 3, and so all include the elements which we found above were not present in Lipscomb. It is our view that, even considering Lipscomb in the light of 35 U.S.C. § 103,[5] the shortcomings of this reference that existed with regard to the Section 102 rejection remain, and they are not alleviated by Perlin. There is no disclosure or teaching of the claimed elements in either of the references and the examiner has not explained, nor can we perceive on our own, any teaching, suggestion or incentive in either reference which would have led one of ordinary skill in the art to modify the teachings of Lipscomb in such a manner as to meet the terms of these claims.

We reach the same conclusions, for the same reasons, with regard to independent claim 16 and dependent claims 17-21. Claim 16 does not require the presence of map data, but recites

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[5] The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See, for example, ***In re Keller***, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

central processor means for generating an environment with avatars therein, and means for communicating portions of the environment to distributed processor means. We differ from the examiner in that it is our opinion that Lipscomb does not disclose an "environment" in keeping with the interpretation established in the appellant's specification for this term. Inasmuch as Perlin merely discloses the use of avatars in computer presentations, and does not cure the defect in Lipscomb, a *prima facie* case of obviousness is lacking on its face. Moreover, we fail to perceive any suggestion that would have motivated one of ordinary skill in the art to modify the teachings of Lipscomb in such a manner as to meet the terms of claim 16 other than the luxury of the hindsight afforded one who first viewed the appellant's disclosure. It is axiomatic that this is not a proper basis for a rejection under Section 103.

For the reasons set forth above, we will not sustain the rejection of claims 2, 8 and 13-21.

SUMMARY

Neither of the rejections is sustained.

The decision of the examiner is reversed.

REVERSED

NEAL E. ABRAMS Administrative Patent Judge	)	
JOHN P. McQUADE Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
JOHN F. GONZALES Administrative Patent Judge	)	

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